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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,163	09/01/2000	Hiroshi Mikitani	KAK-001	5466

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RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/653,163

Applicant(s)

MIKITANI ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Response to Amendment*

Amendment received on 09/26/2003 is acknowledged and entered. Claims 1-10 have been amended. New claims 14 and 15 have been added. Claims 1-15 are currently pending in the application.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-4 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,794,219) in view of Sarno (US 6,024,641).**

Brown teaches a system and method for conducting an on-line auction with bid pooling, comprising:

**As per claim 1**, means for sending an electronic mail in which a unique access key is affixed to one of a plurality of specified participants (C. 5, L. 55-67); means for selecting an application for a lottery on the basis of said unique access key from each of said participants (C. 6, L. 42-52); and means for displaying winners (C. 8, L. 41-43).

Brown does not specifically teach that said means for displaying winners include means for notifying said plurality of participants of a result of said lottery.

Sarno teaches a system and method for lottery gaming, wherein participants are notified of a result of a lottery (C. 6, L. 6-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won or not.

**As per claim 3**, Sarno teaches said system and method wherein the result of said lottery is presented before said electronic mail is sent (C. 6, L. 6-17). The motivation to combine Brown with Sarno would be to announce the results to stimulate non-participants to joint the lottery.

**As per claim 4**, Sarno teaches said system and method wherein a discrimination of the application for said lottery is performed by use of said access key and a destination mail address of said electronic mail (C. 2, L. 49-63; C. 5, L. 30-44). The motivation to combine Brown with Sarno would be to enhance the security of the system.

**As per claim 12**, Brown teaches said system and method wherein data of said participant who applied for the lottery is collected and stored (C. 6, L. 2-52).

**As per claim 13**, Brown teaches said system and method wherein said lottery system is entirely incorporated into a computer system (C. 6, L. 2-52).

**As per claim 14**, Brown teaches: means for sending an electronic mail in which a unique access key is affixed to one of a plurality of specified participants (C. 5, L. 55-67); means for selecting an application for a lottery on the basis of said unique access key from each of said participants (C. 6, L. 42-52); means for determining a result for each participant (C. 8, L. 36-41); and means for displaying winners (C. 8, L. 41-43).

Brown does not specifically teach that said means for displaying winners include means for notifying said plurality of participants of a result of said lottery.

Sarno teaches a system and method for lottery gaming, wherein participants are notified of a result of a lottery (C. 6, L. 6-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won or not.

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Sarno and further in view of Petrecca (US 6,409,593).**

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**As per claim 2**, Brown and Sarno teach all the limitations of claim 2, except that said result of said lottery is obtained by a drawing performed when said participant applies for said lottery.

Petrecca teaches a system and method for drawing for winners over the Internet, wherein a result of a lottery is obtained by a drawing performed when a participant applies for the lottery (C. 4, L. 45-57).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said result of said lottery is obtained by a drawing performed when said participant applies for said lottery, as disclosed in Petrecca, because it would advantageously stimulate customers to play more often.

**Claims 5-9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Sarno in view of McArdle et al. (US 6,442,686) (McArdle).**

**As per claim 5**, Brown and Sarno teach all the limitations of claim 5, except that said access key is an address of an electronic mail sent back by said participant.

McArdle teaches a system and method for cryptographic-enabled messaging system wherein an access key is an address of an electronic mail sent back by said participant (C. 2, L. 7-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said access key is an address of an electronic mail sent back by said participant, as disclosed in McArdle, because it would advantageously simplify the process of logging on to the system.

**As per claim 6**, Sarno teaches said system and method wherein the result of said lottery is performed by notifying a URL of a page informing the result and an access keyword, using an electronic mail (C. 6, L. 14-17). The motivation to combine Brown with Sarno would be to advantageously allow the participants to learn whether they won or not.

**As per claims 7** Sarno teaches said system and method, comprising: notifying said participant of a URL of a page via electronic mail, wherein said page holds the result of said lottery as well as an access keyword (C. 6, L. 14 – C. 7, L. 32). The motivation to combine Brown with Sarno would be to advantageously notify participants almost instantaneously, thereby make the use of the system more attractive to the participants.

**As per claim 8**, Sarno teaches said system and method wherein the URL of the page informing said result is separated into one for a winner of a prize and the other for a loser in winning the prize (Figs. 3B, 6; C. 6, L. 14 – C. 7, L. 32). The motivation to combine Brown with Sarno would be to simplify reading of the lottery results.

**As per claim 9**, Sarno teaches said system and method wherein by entering said access keyword and a mail address to which said access keyword is sent into the page informing said result, a page for the winner of the prize and a page of the loser in winning the prize can be accessed (C. 6, L. 14 – C. 7, L. 32). The motivation to combine Brown with Sarno would be to simplify the access to the results of the lottery.

**As per claim 15**, Brown teaches: sending an electronic mail in which a unique access key is affixed to one of a plurality of specified participants (C. 5, L. 55-67); applying for the lottery by a participant by sending an access key and a participant's electronic mail address (C. 5, L. 55, - C. 6, L. 16); selecting an application for a lottery on the basis of said unique access key from each of said participants (C. 6, L. 42-52); means for determining a result for each participant (C. 8, L. 36-41); and displaying winners (C. 8, L. 41-43).

Brown does not specifically teach that said means for displaying winners include means for instantaneous notifying said plurality of participants of a result of said lottery. Brown also does not teach that said access key is an address of an electronic mail sent back by said participant.

Sarno teaches a system and method for lottery gaming, wherein participants are notified of a result of a lottery immediately after the new winning combinations are determined (C. 6, L. 6-17).

McArdle teaches a system and method for cryptographic-enabled messaging system wherein an access key is an address of an electronic mail sent back by said participant (C. 2, L. 7-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that the participants are notified of a result of a lottery, as disclosed in Sarno, because it would advantageously allow the participants to learn whether they won or not. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said access key is an address of an electronic mail sent back by said participant, as disclosed in McArdle, because it would advantageously simplify the process of logging on to the system.

**Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Sarno and further in view of Kamasaka et al. (US 6,240,455) (Kamasaka).**

**As per claim 10**, Brown and Sarno teach all the limitations of claim 10, except that said access key is a keyword either in a URL of a page for application or in a specified URL.

Kamasaka teaches a system and method for alteration of link destination wherein an access key is a keyword in a URL of a page for application (Figs. 14 and 17; C. 10, L. 29 – C.12, L. 27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Sarno to include that said access key is a keyword in a URL of a page for application, as disclosed in Kamasaka, because it would advantageously enhance the accuracy of the system thereby make it more attractive to the customers.

**As per claim 11**, Sarno teaches said system and method wherein a destination mail address of said electronic mail, which is entered in said URL, is used for

discrimination (C. 2, L. 49-63; C. 5, L. 30-44). The motivation to combine Brown with Sarno would be to enhance the functionality of the system.

### ***Response to Arguments***

Applicant's arguments filed 9/26/2003 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach *means for sending an electronic mail in which a unique access key is affixed*, it is noted that Brown teaches said system and method, wherein the account creation computer transmit a bidder identification number in a new account confirmation message (e-mail) (C. 5, L. 65-66); said bidder identification number is used by the participant to submit bids (to access the system) (C. 7, L. 50-52).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

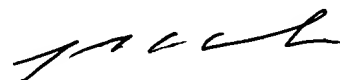
***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



IB. . . . .

1/9/2005

JOHN G. WEISS . .  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600